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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,679	08/08/2005	Roland Isherwood	66307-348	4119
25369 7590 08/21/2009 DYKEMA GOSSETT PLLC FRANKLIN SQUARE, THIRD FLOOR WEST 1300 I STREET, NW WASHINGTON, DC 20005				
EXAMINER				
LEWIS, JUSTIN V				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/541,679

**Applicant(s)**

ISHERWOOD, ROLAND

**Examiner**

JUSTIN V. LEWIS

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25, 27, 28, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25, 27, 28, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2009 and 08 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The instant action replaces the Final Rejection issued on 09 April 2009, pursuant to the agreement of the parties, reached during a telephonic interview conducted on 04 August 2009, said agreement being that Examiner would transmit an explanation of how the limitation of "a magnetic feature which has a varying size and shape along the length of [an] elongated strip" could be found to be unpatentable under 35 USC 103.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10, 13-25, 27-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,354,099 to Kaule et al. ("Kaule") in view of U.S. Patent No. 4,943,093 to Melling et al. ("Melling").

Regarding claim 1, Kaule discloses a security element (paper of value 31) comprising an elongate strip of light transmitting polymeric (see col. 3, lines 47-48) substrate (security element 2), said substrate being provided with a magnetic feature and a metallic design (see col. 3, lines 3-4), the metallic design being provided by a combination of metal and non-metallic regions (see col. 2, lines 47-51) which permit transmission of light (see col. 3, lines 39-41) and comprising indicia, characters, patterns, designs, or geometrical shapes or a combination of the aforesaid design (see fig. 3), a pattern not extending across a full width of the elongated strip (see fig. 3), said

magnetic feature being positioned to not overlap with the metallic design (see figs. 2-4), but fails to disclose at least one repeating pattern of which one or more of frequency, instantaneous amplitude and maximum amplitude of the pattern varies constantly along a length of the element, a design of said magnetic feature having a varying size and shape along the length of the element.

Melling teaches the concept of providing at least one repeating pattern (thread, unnumbered) of which one or more of frequency, instantaneous amplitude and maximum amplitude of the pattern varies constantly along a length of the element (see fig. 13), a design of said magnetic feature having a varying size and shape along the length of the element (see fig. 13).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to give the Kaule magnetic stripes (4) the shape of the Melling thread (seen in fig. 13) in order to provide a security element which may be perceived by members of the public without the use of a special viewing device such as a magnifying glass and a document incorporating such a device can accordingly be recognized as a genuine document, as explicitly taught by Melling (see col. 10, lines 59-64).

Regarding claim 2, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the magnetic feature comprises a continuous layer (see Kaule col. 2, lines 38-45).

Regarding claim 3, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the magnetic feature comprises a discontinuous layer (see Kaule col. 2, lines 38-45).

Regarding claim 4, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the magnetic feature comprises indicia, characters, patterns, designs or geometrical shapes (see Melling fig. 13).

Regarding claim 5, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the magnetic feature comprises a machine readable bit pattern sequence (see Kaule col. 2, lines 47-48).

Regarding claim 6, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the pattern is provided by demetallised regions in a metal layer (see Kaule figs. 2-4).

Regarding claim 7, Kaule in view of Melling discloses the security element as claimed in claim 6 in which the metal layer covers the magnetic feature (see Kaule figs. 2-4).

Regarding claim 8, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the pattern is provided by discrete metal regions (see Kaule col. 2, lines 47-51).

Regarding claim 9, Kaule in view of Melling discloses the security element as claimed in claim 8 in which the magnetic feature is not covered by metal regions (see Kaule figs. 2-4, in light of the combination set forth in the rejection of claim 1, above).

Regarding claim 10, Kaule in view of Melling discloses the security element as claimed in claim 9 in which the magnetic feature is overprinted with a black or coloured ink (see Kaule col. 3, lines 53-54).

Regarding claim 13, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the design of magnetic feature and the pattern of the metallic feature are complementary (see Melling fig. 13 in view of the combination set forth in the rejection of claim 1, above).

Regarding claim 14, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the magnetic feature and the pattern of the metallic feature combine to comprise an authenticating feature (see Melling col. 10, lines 59-64).

Regarding claim 15, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the magnetic feature has an amount of magnetic material which does not vary in any cross section of the security element (see Kaule col. 2, lines 47-51).

Regarding claim 16, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the magnetic feature comprises a plurality of layers of magnetic materials having differing characteristics (see Kaule col. 2, lines 38-45).

Regarding claim 17, Kaule in view of Melling discloses the security element as claimed in claim 1 in which the metallic design is provided by the application of metallic ink to the substrate (see Kaule col. 2, lines 38-45).

Regarding claim 18, Kaule in view of Melling discloses the security element as claimed in claim 17 in which the design is provided by a plurality of layers of metallic inks having differing characteristics (see Kaule col. 2, lines 38-45).

Regarding claim 19, Kaule in view of Melling discloses the security element as claimed in claim 1 in which a layer which has a functional effect, such as luminescence

or IR absorbing, is applied to the element (see Kaule col. 2, lines 21-25; see also col. 2, line 67- col. 3, line 1).

Regarding claim 20, Kaule in view of Melling discloses the security substrate comprising a base substrate in which a security element according to claim 1 is at least partially embedded (see Kaule col. 1, lines 5-8).

Regarding claim 21, Kaule in view of Melling discloses the security substrate comprising a base substrate to at least one surface of which a security element according to claim 1 (see Kaule col. 1, lines 5-8).

Regarding claim 22, Kaule in view of Melling discloses the security document made from the security substrate of claim 20 (see Kaule col. 1, lines 5-8).

Regarding claim 23, Kaule in view of Melling discloses the security document as claimed in claim 22, wherein at least one side thereof is printed with identifying indicia (see Kaule claim 11).

Regarding claim 24, Kaule in view of Melling discloses the security document as claimed in claim 23 in which the printing includes at least one of the repeating patterns of the metallic design (see the combination set forth in the rejection of claim 1, above).

Regarding claim 25, Kaule in view of Melling discloses the security document as claimed in claim 22, comprising a bank note, cheque, ID card, bond, certificate of authenticity, stamp, security label, vouchers or brand protection article (see Kaule col. 1, lines 5-6).

Regarding claim 27, Kaule in view of Melling discloses a security document made from the security substrate of claim 21 (see Kaule col. 1, lines 5-8).

Regarding claim 28, Kaule in view of Melling discloses the security document according to claim 27, wherein at least one side thereof is printed with identifying indicia (see Kaule claim 11).

Regarding claim 30, Kaule in view of Melling discloses a security element (Kaule paper of value 1) comprising an elongate strip of a light transmitting polymeric (see Kaule col. 3, lines 47-48) substrate (security element 42), said substrate being provided with a magnetic feature (see Kaule col. 3, lines 3-4) and a metallic design (see the combination set forth in the rejection of claim 1, above), the metallic design being provided by a combination of metal and non-metallic regions (see the combination set forth in the rejection of claim 1, above) which permit the transmission of light (see Kaule col. 3, lines 39-41) and comprising indicia, characters, patterns, designs, or geometrical shapes or a combination of the aforesaid design (see Melling fig. 13) incorporating at least one repeating pattern (see the Melling fig. 13) of which one or more of the frequency, the instantaneous amplitude and/or the maximum amplitude of the pattern varies constantly along the length of the element (see Kaule fig. 3), the design of the magnetic feature being complementary to the pattern of the metallic design and said magnetic feature being positioned to not overlap with the metallic design (see Kaule figs. 2-4; see also Melling fig. 13; see the combination set forth in the rejection of claim 1, above).

Regarding claim 31, Kaule in view of Melling discloses a security element (Kaule paper of value 1) comprising an elongate strip of a light transmitting polymeric (see Kaule col. 3, lines 47-48) substrate (Kaule security element 2), said substrate being



provided with a magnetic feature and a metallic design (see Kaule col. 3, lines 3-4), the metallic design being provided by a combination of metal and non-metallic regions (see Kaule col. 2, lines 47-51) which permit the transmission of light (see Kaule col. 3, lines 39-41) and comprising indicia, characters, patterns, designs, or geometrical shapes or a combination of the aforesaid design (see Melling fig. 3) incorporating at least one repeating pattern (see Melling fig. 3) of which one or more of the frequency, the instantaneous amplitude and/or the maximum amplitude of the pattern varies constantly along the length of the element (see Melling fig. 3), the design of the magnetic feature having a varying height, the height and design variation being such that the amount of magnetic material present in any cross section of the security element is constant and said magnetic feature being positioned to not overlap with the metallic design (see Kaule figs. 2-4; see also Melling fig. 13; see the combination set forth in the rejection of claim 1, above).

4. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule in view of Melling and further in view of U.S. Patent Application Publication No. 2002/0090556 to Jotcham et al. ("Jotcham").

Regarding claim 11, Kaule in view of Melling discloses the security element as claimed in claim 9, but fails to disclose a layer of optically variable, photochromatic or thermochromatic material being provided over at least the magnetic feature.

Jotcham teaches the concept of providing an optically variable masking layer (see paragraph 17, lines 5-6).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to dispose a Jotcham optically variable masking layer over the security element of Kaule in view of Melling in order to disguise the appearance of the security element when viewed by the naked eye, as explicitly taught by Jotcham (see paragraph 17).

Regarding claim 12, Kaule in view of Melling and further in view of Jotcham discloses the security element as claimed in claim 9 in which a masking layer is provided over the magnetic feature (see the combination set forth in the rejection of claim 11, above) having a color at least as dark as that of the magnetic feature to disguise the format of the magnetic feature (see Jotcham paragraph 17).

### ***Response to Arguments***

In response to Applicant's statements regarding a magnetic feature which has a varying size and shape along the length of an elongated strip, Examiner asserts that the combination of Kaule in view of Melling (as set forth in the rejection of claim 1, above) satisfies said limitation.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN V. LEWIS whose telephone number is (571)270-5052. The examiner can normally be reached on M-F 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571) 272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dana Ross/  
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/JVL/